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EXAMINER

LEE, PHILIP C

ART UNIT	PAPER NUMBER
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2154

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/770,556
Filing Date: January 26, 2001
Appellant(s): KRISHNAN ET AL.

Venkatesh Krishnan
Jean Tourrihes
Jeffrey A. Morgan
For Appellant

EXAMINER'S ANSWER

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(4) *Status of Amendments*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 03/15/2005 has been entered.

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

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(7) *Claims Appendix*

A substantially correct copy of appealed claims 18-34 appear on page 22-26 of the Appendix to the appellant's brief. The minor errors are as follows: the serial no. 09/560908 and group art unit: 2187 are incorrect. The correct serial no. is 09/770556 and group art unit is 2154.

(8) *Evidence Relied Upon*

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 18, 24 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to teach a memory for automatically storing said web address and a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order.

Claim Rejections – 35 USC 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 18-22, 24-28 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiser et al, U.S. Patent 5,982,520 (hereinafter Weiser) in view of Utsumi, U.S. Patent 6,243,741 (hereinafter Utsumi).

4. Weiser and Utsumi were cited in the last office action.

5. As per claims 18, Weiser taught the invention substantially as claimed for wirelessly interacting with an Internet appliance, said device comprising:

a receiver for wirelessly receiving digital information from a first Internet appliance (col. 4, lines 20-22, 57-60; col. 5, lines 15-25);

a memory for automatically storing said digital information received from said first Internet appliance (col. 5, lines 19-25); and

a transmitter for wirelessly providing said digital information to a second Internet appliance (col. 4, lines 20-22, 57-60; col. 5, lines 15-25).

6. Weiser did not specifically detailing types of digital information. Utsumi taught transmitting a web address (URL) for Internet broadcast television program (col. 5, lines 52-55; col. 7, lines 22-42). Utsumi further taught a preference control for organizing said portable device transfer of said web address for said Internet broadcast television program (comprised both audio and video broadcast) to said second Internet appliance in a selected order (col. 7, lines 37-42, 50-52).

7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Weiser and Utsumi because Utsumi's teaching of transmitting a web address would increase the user flexibility of Weiser's system by allowing remote transmission of web address (URL) to an Internet television for accessing the Internet (col. 7, lines 22-31).

8. As per claim 24, Weiser taught the invention substantially as claimed for wirelessly interacting with an Internet appliance, said device comprising:

a receiver for wirelessly receiving digital information from a first Internet appliance (col. 4, lines 20-22, 57-60; col. 5, lines 15-25);

a memory for automatically storing said digital information received from said first Internet appliance (col. 5, lines 19-25); and

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a transmitter for wirelessly providing said digital information to a second Internet appliance (col. 4, lines 20-22, 57-60; col. 5, lines 15-25).

9. Weiser did not specifically detailing types of digital information. Utsumi taught transmitting a web address (URL) for Internet broadcast television program (i.e. comprised both Internet audio and video broadcast) (col. 6, lines 14-15; col. 5, lines 52-55; col. 7, lines 22-42). Utsumi further taught a preference control for organizing said portable device transfer of said web address for said Internet broadcast television program to said second Internet appliance in a selected order (col. 7, lines 37-42, 50-52).

10. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Weiser and Utsumi because Utsumi's teaching of transmitting a web address would increase the user flexibility of Weiser's system by allowing remote transmission of web address (URL) to an Internet television for accessing the Internet (col. 7, lines 22-31).

11. As per claim 30, Weiser taught the invention substantially as claimed for wirelessly interacting with an Internet appliance comprising:

receiving a web address from a first Internet appliance (col. 4, lines 20-22, 57-60; col. 5, lines 15-25);

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storing said web address received from said first Internet appliance on said portable device (col. 5, lines 19-25), wherein said portable device is a key chain tag-sized device (fig.2; col. 3, lines 3-10; col. 4, lines 54-col. 5, lines 4); and providing said web address to a second Internet appliance (col. 4, lines 20-22, 57-60; col. 5, lines 15-25).

12. Weiser did not specifically detailing types of digital information. Utsumi taught transmitting a web address (URL) for Internet broadcast television program (i.e. comprised both Internet audio and video broadcast) (col. 6, lines 14-15; col. 5, lines 52-55; col. 7, lines 22-42). Utsumi further taught organizing said portable device transfer of said web address for said Internet broadcast television program to said second Internet appliance in a selected order (col. 7, lines 37-42, 50-52).

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Weiser and Utsumi because Utsumi's teaching of transmitting a web address would increase the user flexibility of Weiser's system by allowing remote transmission of web address (URL) to an Internet television for accessing the Internet (col. 7, lines 22-31).

14. As per claims 19, 25 and 31, Weiser and Utsumi taught the invention substantially as claimed in claims 18, 24 and 30 above. Weiser further taught a user interface to cause the

transmitter or receiver to transmit or receive the web address for said Internet audio/video broadcast in response to a user control command received from the user interface (fig. 2; col. 3, lines 3-10; col. 4, lines 54-67; col. 3, lines 18-22, 52-53; col. 6, lines 59-62).

15. As per claims 20 and 26, Weiser and Utsumi taught the invention substantially as claimed in claims 18 and 24 above. Weiser further taught wherein said portable device is a key chain tag-sized device (fig.2; col. 3, lines 3-10; col. 4, lines 54-col. 5, lines 4).

16. As per claims 21, 27 and 32, Weiser and Utsumi taught the invention substantially as claimed in claims 18, 24 and 30 above. Weiser further taught wherein the transmitter comprises:
a beacon transmitter that transmits wirelessly a beacon signal containing the web address for said Internet audio/video broadcast, wherein the beacon transmitter has a predetermined transmission range (col. 3, lines 39-45; col. 4, lines 57-60; col. 5, lines 13-25).

17. As per claims 22, 28 and 33, Weiser and Utsumi taught the invention substantially as claimed in claims 18, 24 and 30 above. Weiser further taught wherein the receiver comprises:
a beacon receiver that receives an external electronic transmission containing the web address for said Internet audio/video broadcast, and extracts the web address for said Internet audio/video broadcast from the transmission (col. 4, lines 57-60; col. 7, lines 13-17; col. 8, lines 30-34).

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18. Claims 23, 29 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiser and Utsumi in view of Wiener et al, U.S. Patent 6,701,317 (hereinafter Wiener).

19. Wiener was cited in the last office action.

20. As per claims 23, 29 and 34, Weiser and Utsumi taught the invention substantially as claimed in claims 18, 24 and 30 above. Weiser and Utsumi did not teach partitioning the storage area. Wiener taught wherein the storage is partitioned into a general storage area and a customized storage area that stores user-specified web addresses (col. 8, lines 47-col. 9, lines 5).

21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Weiser, Utsumi and Wiener because Wiener's method of partitioning the storage area would increase the user flexibility of Weiser's and Utsumi's systems by allowing the user to store important web addresses (URLs) in different partitioned storage (col.8, lines 47-53).

(10) Response to Argument

The examiner summarizes the various points raised by the appellant and addresses replies individually.

Appellant argued that:

- (1) Recited features "a memory for automatically storing said web address" and "a preference control for organizing said portable device transfer of said web address

to said second Internet appliance in a selected order” of claims 18, 24 and 30 are well supported in the specification.

(2) Utsumi does not overcome the deficiencies of Weiser et al, and neither Weiser et al nor Utsumi, alone or in combination, teach, disclose or suggest the limitation of claims 17, 21 and 28. Appellant does not understand the teaching of Utsumi to provide any reception capabilities either wired or wireless.

(3) One of ordinary skill in the art would find no motivation to combine Utsumi, teaching a remote control for a web based TV application with extremely limited capabilities and no application running capability, with McClure, which teaches a device that can run applications, etc.

In reply to argument (1): In response to applicant's arguments on pages 13-15, filed 6/10/05 are insufficient to overcome the rejection of claims 18, 23 and 30 under 35 U.S.C § 112, first paragraph, as set forth in the final office action mailed on 1/10/05 because it fails to provide description in the specification to support the claimed features.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Appellant has attempted to overcome rejection of claims 18, 23 and 30 under 35 U.S.C § 112, first paragraph in the amendment after final office action submitted on 3/15/05. Specifically, appellant amended claims 18, 23 and 30 to state: “a

memory for storing said web address”, deleting the feature of “automatically”.

Accordingly, the rejection with respect to this feature is withdrawn.

As for appellant’s argument for support the feature of “a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order”, it has been fully considered but are not deemed to be persuasive. Particularly, in page 13, paragraph 4 of the appeal brief states: “ the feature of a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order is well supported in the Figure, e.g., Figure 5 control button 38 and throughout the specification including the following paragraphs:

(0055) The other function of the control button 38 is referred to as "tag me" function which is basically a bookmark function. This function allows the remote operator 10 to tag a web address and to send the tagged web address when needed. This button allows the user of the remote operator 10 to select personalized web addresses and store them separately in the customized storage area of the storage 43. The CUSTOMIZED button 38, when pressed, normally causes the first function to be performed. When the user of the remote operator 10 wants to use the button 38 for the second function, the user can press the button down for a predetermined period of time (e.g., five seconds). This will cause the button to be switched to the second functional mode.

(0057) In another embodiment. the UP and DOWN control buttons

31-32 can be programmed to move the web addresses stored in the storage 43 to the top or bottom entry of the storage 43. In addition, the UP and DOWN buttons 31-32 can also be used to move the personalized or book-marked web addresses in and out of the special storage entry (i.e. the "ME" storage entry) in the customized storage area of the storage 43. That "ME" storage entry stores the personalized web address to be sent to external Internet appliance. This transmission is activated or triggered by the user pressing the CUSTOMIZED button 38."

This amounts to only functionalities of the control buttons 31-32 and 38. There is not explanation of the "preference control". In fact, the term "preference control" was never mention in the specification. One person skilled in the art could interpret "preference control" as selecting data transferring format (e.g. data type), setting transfer speed, or channel selection, a broader interpretation than just "control buttons". The term used (i.e. preference control) cannot be support by the functionalities of the control buttons.

Accordingly, appellant has not provide support for the claim feature of "a preference control for organizing said portable device transfer of said web address to said second Internet appliance in a selected order". The rejection for this feature is maintained.

In reply to argument (2): On page 17, paragraph 1 of the Appeal Brief, Appellant states “Consequently, Utsumi does not overcome the deficiencies of Weiser et al., and neither Weiser et al. nor Utsumi, alone or in combination, teach, disclose or suggest the limitations of Claims 17, 21 and 28.” This is clearly a mistake made by the Appellant because the argument on pages 16 and 17 does not correspond to the limitations of claims 17, 21 and 28. In addition, claim 17 has been canceled in the amendment after final submitted by the appellant on 3/15/05. Furthermore, since claims 21 and 28 depend on independent claims 18 and 24, even if the arguments for claims 21 and 28 are persuasive, it will not overcome the rejection of Independent claims 18, 24 and 30. Accordingly, the response to the arguments on pages 16 and 17 will be addressed to claims 18, 24 and 30.

Appellant’s argument in respect to claims 18, 24 and 30 has been considered but are not deemed to be persuasive. In particular, page 17, paragraph 1, states: “Applicant does not understand the remote commander of Utsumi to provide any reception capabilities either wired or wireless”, and “Applicant understands Utsumi to provide only the standard manual keypad type input capabilities”.

As per claims 18, 24 and 30, they are rejected under 35 U.S.C. 103 (a) as being unpatentable over Weiser et al in view of Utsumi. This means that the combination of Weiser et al and Utsumi taught the features of claims 18, 24 and 30. Specifically, Weiser et al taught the method comprising the steps of wirelessly receiving (i.e. reception capabilities by wireless) and transmitting digital information

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except that the digital information is web address. Utsumi overcome the deficiencies of Weiser et al, by teaching the steps of transmitting a web address (URL) (i.e. digital information) for Internet broadcast television program (col. 5, lines 52-55; col. 7, lines 22-42). This means that web address is a form of digital information because web address is used for Internet broadcast television program. It is known in the art that information used for Internet TV must be in digital form. Furthermore, Utsumi taught two reception means for inputting URL address. First, the URL address which has been stored in the remote commander by the user (col. 7, lines 37-39). Second, the URL address which has been stored in the remote commander before marketed (col. 7, lines 37-39). The second method means that the URL address stored in the memory of the remote commander (e.g. ROM) must be programmed by a device instead of inputting by a user. The programming of URL address must be performed by a device either through wired or wireless reception means.

In conclusion, One of ordinary skill in the art can use Weiser's device with wireless reception means with Utsumi's teaching of downloading the web address from a device (i.e. programming of URL address by a device), store the web address on Weiser's device, and provide the web address to a internet appliance (i.e. transmitting the web address to another device). Accordingly, Weiser et al and Utsumi, in combination, taught the wireless reception capabilities for digital information such as web address.

In reply to argument (3): On page 17, paragraph 1 of the Appeal Brief, Appellant states “One of ordinary skill in the art would find no motivation to combine Utsumi, teaching a remote control for a web based TV application with extremely limited capabilities and no application running capability, with McClure, which teaches a device that can run applications, etc.” This is clearly another mistake made by the Appellant because the appellant or the examiner never cited McClure as a prior art of record. Furthermore, on page 7 of the appeal brief, under the heading Grounds of Rejection to be Reviewed on Appeal, claims 18, 24 and 30 are grouped as being unpatentable over Weiser et al in view of Utsumi, not McClure. Accordingly, responses will be addressed to Weiser et al in view of Utsumi.

On page 17, paragraph 5 to page 18, paragraph 1, appellant states: “ the suggested modification of Weiser et al, in view of Utsumi would change the principle of operation of Weiser et al.” Appellant continue to states “ Weiser et al has an extensive discussion teaching away from devices that do not provide a broad range of programmable functions.”

The suggested modification of Weiser et al in view of Utsumi would not change the principle of operation of Weiser et al. In fact, Weiser et al suggest that it would desirable to have a device to include the use of digital information such as web page site identifier (i.e. web address or URL). In particular, column 2, lines 3-16 of Weiser et al states:

For transfer of small amounts of data in diverse formats, what is needed is a device having some of the programmable flexibility of a personal digital assistant, with the size and battery power requirements of a pager or smart card. Such a device is much more likely to be carried by a user than a personal digital assistant, and would still provide significantly greater data transfer options than a smart card. Contemplated applications for a device intermediate in

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functionality and power usage between a smart card and a personal digital assistant include storage of long term data such as name, address, telephone numbers, driver license number, social security number, medical information, *personal or corporate web page site identifiers*,...

One of ordinary skill in the art would realize the modification of Weiser et al in view of Utsumi's teaching of using digital information such as web address would at most require to simply update the software of Weiser et al's system to process web address which is just another form of digital information. Therefore, one of ordinary skill in the art would be motivated to combine Weiser et al and Utsumi because of the needs for a device to include the use of web address, and the simple modification of Weiser et al in view of Utsumi.

In addition, on page 4, paragraph 11 of the final office action mailed on 1/10/05 states: "It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Weiser and Utsumi because Utsumi's teaching of transmitting a web address would increase the user flexibility of Weiser's system by allowing remote transmission of web address (URL) to an Internet television for accessing the Internet (col. 7, lines 22-31)."

(11) *Related Proceeding(s) Appendix*

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

(12) *Conclusion*

For the above reasons, it is believed that the rejections should be sustained.


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Respectfully submitted,

Philip C. Lee
November 22, 2005

Conferees:


SUPERVISORY PATENT EXAMINER
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RUPAL DHARIA
SUPERVISORY PATENT EXAMINER